

Appl. No. 10/715,752
Docket No. CM2543CQ
Amdt. dated November 22, 2006
Reply to Office Action mailed on August 23, 2006
Customer No. 27752

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REMARKS

Claim Status

Claims 1 - 14 are pending in the present application. No additional claims fee is believed to be due.

Claim 2 has been amended to include the feature of an extruder-applicator. Support for this amendment is found at page 9, lines 12 - 13 of the specification. Claim 2 has also been amended to correct a grammatical error regarding the word "and."

Rejection Under 35 USC §§102/103 Over Hefe

Claim 2 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hefe (U.S. Pat. No. 5,569,348, hereafter "Hefe I"). Applicant respectfully traverses the rejection.

The Office Action states "The adhesive is applied onto a surface of a roller, i.e. first tool . . . by means of a coater unit (28) that has a multitude of applicators, in the form of surface cavities, and a hot melt doctor blade (32) to assist the gravure printing process." The Office Action, page 3, first paragraph.

The law is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found . . . in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Additionally, it is well settled that in order to establish a prima facie case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.*

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In the present case, Applicant asserts that Hefe I does not teach or suggest a process for applying an active material onto an article, series of articles or web of articles, comprising the steps of: a) applying said active material to a surface of a first tool; and b) transferring said active material from the surface of the first tool to an article, series of articles or web of articles, supported on a surface of a second tool and pressed against the surface of the first tool, wherein the active material in step a) is applied in the form of a multitude of beads with a coater having a multitude of extruder-applicators, which are in close proximity to the surface of the first tool; wherein the coater is heated such that the active material is applied at a temperature between 70 degrees C and 250 degrees C. Specifically, Hefe I does not teach or suggest a coater having a multitude of extruder-applicators. As stated in the Office Action, the coater of Hefe I has applicators in the form of surface cavities, not extruders, as is recited in claim 2 of the present application.

In light of these remarks, it is Applicant's position that Hefe I does not teach or suggest each and every element of claim 2. Accordingly, Applicant respectfully requests the rejection of claim 2 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hefe I, be reconsidered and withdrawn.

Rejection Under 35 USC §103(a) Over Sirota in view of Koehn and Goodnow

Claims 1, 2, and 3 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sirota (U.S. Pat. No. 3,574,153, hereafter "Sirota") in view of Koehn (U.S. Pat. No. 6,475,283, hereafter "Koehn") and Goodnow, *et al.*, (U.S. Pat. No. 4,906,335, hereafter "Goodnow"). Applicant respectfully traverses the rejection.

The Office Action states

Sirota teaches a process of applying hot melt adhesive compositions onto flexible web substrates. A pot, i.e. coater unit (10), dispenses adhesive (11) over a roller (12) and the adhesive application is controlled by a doctor blade (13) and applied to the substrate which is pulled over a pressure roller (15) (abstract; column 5, line 16 and lines 44-48). The adhesive is applied at temperature in the range of 250°F-400°F, or 121°C-204°C (column 5, lines 24-25).

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Sirota does not teach applying adhesive as a multitude of beads with a coater unit having a multitude of applicators. Koehn teaches applying a patterned (block) adhesive by means of nozzles (6) supported on a bar (5) (column 1, lines 25-31; column 3, lines 37-38; Figures 1 and 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to perform coating as Koehn taught and would have been motivated to do so the adhesive can refrain from leakage and thus, no time consuming cleaning procedure is necessary after applications.

Furthermore, Sirota does not teach positioning a doctor blade at a certain angle tangent to the surface of a roller. Goodnow et al. teach optimizing the angle of a doctor blade against a rotating surface (column 1, lines 20-34).

Although Goodnow et al. do not specify a certain angle of the doctor blade tangent to the surface of a roller, the positioning of the doctor blade is taught so material is applied evenly and no damage or overflow can potentially occur. Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to use the teaching of Goodnow et al. to position a doctor blade accurately.

The Office Action, page 4, generally.

With regard to claim 2, Applicant is unable to find any disclosure in Sirota, Koehn or Goodnow directed to applying an active material in the form of a multitude of beads with a coater having a multitude of extruder-applicators, as is recited in claim 2 of the present application. In addition, the Office Action does not point to any particular portion of the cited disclosures for such teaching or suggestion.

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

37 CFR §1.104(c)(2). It is Applicant's position that Sirota in view of Koehn and Goodnow fail to teach or suggest each and every element of claim 2 of the present application.

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With regard to claims 1 and 3, the above remarks are equally applicable. Claim 1 recites applying said active material to a surface of a first tool in the form of a multitude of beads, and Applicant is unable to find any such teaching or suggestion in the cited disclosures. Thus, it is Applicant's position that Sirota in view of Koehn and Goodnow fail to teach or suggest each and every element of claim 1 or claim 3, which depends from claim 1.

Further, Applicant asserts that the combination of Sirota and Koehn is improper because Koehn actually teaches away from claims 1 and 2 of the present application. It is well settled that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). It is also well settled that "a reference may be said to teach away...if it suggests that the line of development flowing from the reference disclosure is unlikely to be productive of the result sought by the applicant." *Tec Air Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353 (Fed. Cir. 1999).

Koehn discloses "[w]ith the adhesive applicator of the invention arbitrary formats of adhesive applications can be sprayed on the roller through suitable control of the adhesive nozzles." Koehn, col. 1, lines 49 - 51. The use of the term "spray" by Koehn implies a substance being dispersed in the form of small drops or finely divided particles. Applicant is unable to find any disclosure in Koehn that shows where spraying an adhesive onto a roller is the same as applying an active material to a surface of a first tool in the form of a multitude of beads, as is disclosed in the claim 1 of the present application. Thus, absent any disclosure to the contrary, it is Applicant's position that one of ordinary skill in the art would not look to the spray nozzles of Koehn for a suitable means of applying an active material to a surface of a first tool in the form of a multitude of beads.

The Office correctly states that Sirota does not teach positioning a doctor blade at a certain angle tangent to the surface of a roller, as is recited in claim 1 of the present

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application. The Office looks to Goodnow to find the missing disclosure. However, Applicant must respectfully disagree with the Office's reading of Goodnow with regard to optimizing the angle of a doctor blade against a rotating surface. Applicant asserts that Goodnow merely discloses the problems associated with not having an optimum blade angle, but offers no solution. Specifically, Goodnow states "If the blade angle is too large, the blade will have a tendency to dig or jam . . . whereas if the blade angle is too small, the doctored material will escape beneath the blade." Goodnow, col. 1, lines 23 – 27. Applicant is unable to find any enabling disclosure in Goodnow directed to actually finding an optimum angle or whether the procedure for finding the optimum angle differs for different processes. Additionally, Applicant is unable to find any teaching or suggestion that the optimum angle of the doctor blade of Goodnow is the same as a coating blade which has an angle of between 5° and 40° with the tangent of the surface of a first tool, as is recited in claim 1 of the present application.

In light of the foregoing remarks, it is Applicant's position that Sirota in view of Koehn and Goodnow do not teach or suggest each and every element of claims 1, 2, or 3. Accordingly, Applicant respectfully requests that the rejection of claims 1, 2, and 3 under 35 U.S.C. §103(a) over Sirota in view of Koehn and Goodnow be reconsidered and withdrawn.

**Rejection Under 35 USC §103(a) Over Lender in view of Koehn and
Goodnow**

Claims 1, 2, 3, and 11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lender, *et al.*, (EP 0978263, hereafter "Lender") in view of Koehn and Goodnow. Applicant respectfully traverses the rejection.

The Office Action states

Lender *et al.* teach a process of applying hot melt adhesive compositions onto articles. A coater unit (36) dispenses adhesive on an engraved roller (31) and the adhesive application is controlled by a doctor blade (35), applied to the article (11) applied at an average temperature 110 °C and is pulled around a roller (11) (abstract; column

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9, lines 17-18; column 10, lines 45-58; column 11, lines 7-12; Figures 1 and 3).

Lender et al. do not teach applying adhesive as a multitude of beads with a coater unit having a multitude of applicators.

The Office Action, page 5, first two paragraphs. Even assuming, *arguendo*, that Lender contains the disclosure for which it is cited, the remarks made above with regard to Koehn and Goodnow are equally applicable to the instant rejection. Specifically, by disclosing spray nozzles, Koehn actually teaches away from the recitation of claim 1, and by not providing any sort of enabling disclosure on how to find an optimum angle, Goodnow does not teach or suggest a coating blade which has an angle of between 5° and 40° with the tangent of the surface of a first tool, as is recited in claim 1 of the present application. Additionally, Applicant asserts that Lender does not provide the necessary disclosure to overcome the failings of Koehn and Goodnow. Because claims 3 and 11 depend from claim 1, the above remarks apply to these claims for the same reasoning.

It is Applicant's position that Lender in view of Koehn and Goodnow do not teach or suggest each and every element of claims 1, 3, or 11, in view of the above remarks. Accordingly, Applicant respectfully requests the rejection of claims 1, 3, and 11 be reconsidered and withdrawn.

Rejection Under 35 USC §103(a) Over Yajima in view of Herzog and Hefe

Claims 1, 3, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yajima, *et al.*, (U.S. Pat. No. 4,343,260, hereafter "Yajima") in view of Herzog (US 3,762,365, hereafter "Herzog") and Hefe (US 4,141,313, hereafter Hefe II). Applicant respectfully traverses the rejection.

Yajima teaches an apparatus for "applying a liquid to a cloth or the like including a stamp roll having a peripheral surface provided with a pattern of pits." (Abstract). Yajima further teaches that "[a] material in liquid state is supplied from a supply

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container 5 to the rubbing block 4 through which the liquid material is fed into the individual pits 1." (col. 1, lines 40-42). Applicants note that Yajima makes several other references to the applied material being in a liquid state. (See col. 2, lines 12-14; lines 17-24; lines 39-42; and lines 58-60).

The Office Action states "Yajima et al. do not teach heating a coater unit placed around the engraved roller to a specified temperature." The Office Action page, 6, second paragraph. The Office looks to Herzog for the missing disclosure. The Office Action also states "Yajima et al. in view of Herzog do not teach a multitude of applicators and angle of the scraper blade." The Office Action, page 6, fourth paragraph.

Even assuming, *arguendo*, that Herzog provides the disclosure for which it is cited, the proposed modification of Yajima and Herzog with Hefe II is still not sufficient to render the claims *prima facie* obvious. Case law clearly states, "[i]t is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986). The Office has selectively chosen portions of Hefe II to support the position that Hefe II will provide disclosure directed to a multitude of applicators and an angle of a scraper blade to the exclusion of the parts directed to use with a powder, *i.e.* solid material.

Hefe II teaches "[a] process and apparatus for the patterned deposition of powdered thermoplastics adhesive material on the outer surface of a textile." (Abstract). However, in contrast to Yajima and Herzog, Hefe II teaches that an adhesive powder is raked "in a pattern of depressions formed in an engraved component" and "then on this powder a further adhesive powder is insertion raked in the depressions." (Abstract). Hefe II states "[p]rior to conception of the present invention it was not to be expected . . . that after filling the depressions of the engraved component with the first adhesive powder by a first rake that yet another substantial quantity of a further adhesive powder

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could be superposed in a sufficiently localized manner” Hefe II, col. 3, lines 13 – 20. Clearly, Hefe II seeks to address the problems associated with combining two or more powders on a single engraved roll, and not to “provide a fuller adhesive pattern coating on the surface [of a first tool],” as is stated in the Office Action at page 7, second full paragraph. Thus, the Office Action has not provided sufficient evidence that one of ordinary skill in the art would be motivated to combine Hefe II with Yajima and Herzog for the cited disclosure.

Further, in attempting to show that Hefe II discloses a coating blade which has an angle of between 5° and 40° degrees with the tangent of the surface of the first tool and which applies a constant pressure onto the surface with active material, the Office Action states “the amount of adhesive shown in the pattern is dependent on the angle of the blade.” The Office Action, page 7, first full paragraph. However, Applicant points out that both the angle of the rake and the distance of the rake from the roll in Hefe II may be effected by the fact that the physical properties of the Yajima material and the Hefe II material (liquid versus solid) are substantially different. Absent any disclosure to the contrary, it is Applicant’s position that the Office has not provided sufficient evidence to show that one of ordinary skill in the art would be motivated to modify Yajima with the rake of Hefe II. Accordingly, Applicant respectfully submits that the combination of Yajima and Hefe II is improper.

Notwithstanding the above remarks, even if the Office did not impermissively pick and choose only those portions of Hefe II which support the stated position, case law provides that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP § 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). In this case, the court reversed an obviousness rejection and held that the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under

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which the [primary reference] construction was designed to operate.” *Id.* (citing 270 F.2d at 813, 123 USPQ at 352).

Yajima discloses the use of an adhesive in the liquefied state while Hefe II discloses the use of an adhesive in a powdered state. As stated above, due to the difference in physical properties between liquids and solids, the proposed modification by the Office could change the basic principle by which the apparatus of Yajima operates. Namely, the rake and applicators of Hefe II, which are intended for use with solid materials, when combined with the liquid applicator system of Yajima would not function according to the same basic principle without substantial redesign. Therefore, Applicants assert that the proposed modification is not sufficient to establish a *prima facie* case of obviousness.

Additionally, Applicants respectfully assert that the Office’s proposed modification to Yajima would render Yajima unsatisfactory for its intended purpose. Case law provides that “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

Yajima states that “[a]n object of the present invention is to provide an apparatus for applying a liquid state material onto a surface of a cloth or the like by which the liquid can be uniformly and continuously applied in dot pattern.” (col. 1, lines 16-20). In contrast, as stated previously, Hefe II teaches the application of an adhesive powder to an engraved roll. Hefe II teaches that the engraved roll is at a lower temperature than the melting point of the adhesive powder. (See Example 1, col. 8, lines 8-24; col. 8 line 65 through col. 9 line 6). Additionally, Hefe II discloses that “[i]n the course of further rotation of the engraved roller the powder coatings 27, 28 then become adhered to this surface form.” (col. 6, lines 51-53). Thus, instead of the application of a liquid material onto a surface, Hefe II teaches the application of a powder to a surface. Because, Hefe II teaches the application of a powder to the surface as opposed to a liquid, Hefe II

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II contradicts the purpose of Yajima. Accordingly, Applicants assert that there is no motivation to combine the suggested references.

For the foregoing reasons, Applicant asserts that the Office has failed to establish a *prima facie* case of obviousness against claim 1. Additionally, at least for the reasons stated above and because claims 3 and 11 depend from claim 1, Applicants assert that the Office has failed to establish a *prima facie* case of obviousness against claims 3 and 11. Accordingly, Applicants respectfully request that the rejection of claims 1, 3, and 11 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

**Rejection Under 35 USC §103(a) Over Yajima, in View of Herzog and Hefe II, and
Further in View of Lender and Friesch**

Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Yajima in view of Herzog and Hefe as applied to claim 3, and further in view of Lender et al. (EP 0978263, hereafter "Lender") and Friesch (U.S. Pat. No. 5,064,492, hereafter "Friesch"). Applicant respectfully traverses the rejection.

In light of the above remarks, Applicant respectfully submits that Yajima in view of Herzog and Hefe II is not sufficient to make a *prima facie* case of obviousness against claim 4 for the same reasons as stated above. Additionally, Applicant asserts that Lender and Friesch do not provide the necessary teaching or suggestion to overcome the failings of the cited disclosures and make a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that the rejection of claim 4 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

**Rejection Under 35 USC §103(a) Over Yajima, in View of Herzog and Hefe II, and
Further in View of Hefe I**

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Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yajima in view of Herzog and Hefe I as applied to claim 3, and further in view of Hefe I. Applicant respectfully traverses the rejection.

In light of the above remarks, Applicant respectfully submits that Yajima in view of Herzog and Hefe I is not sufficient to make a *prima facie* case of obviousness against claim 7 for the same reasons as stated above. Additionally, Applicant asserts that Hefe I does not provide the necessary teaching or suggestion to overcome the failings of the cited disclosures and make a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that the rejection of claim 7 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

**Rejection Under 35 USC §103(a) Over Yajima, in View of Herzog and Hefe I, and
Further in View of Kaylor**

Claims 10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yajima et al. in view of Herzog and Hefe I as applied to claim 1, and further in view of Kaylor, *et al.*, (Pub. No. 2003/0138570, hereafter "Kaylor"). Applicant respectfully traverses the rejection.

In light of the above remarks, Applicant respectfully submits that Yajima in view of Herzog and Hefe I is not sufficient to make a *prima facie* case of obviousness against claims 10, 12 and 13 for the same reasons as stated above. Additionally, Applicant asserts that Kaylor does not provide the necessary teaching or suggestion to overcome the failings of the cited disclosures and make a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that the rejection of claims 10, 12 and 13 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

**Rejection Under 35 USC §103(a) Over Yajima, in View of Herzog and Hefe I, and
Hefe I and Further in View of Datta**

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Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yajima in view of Herzog and Hefe II, and Hefe I as applied to claim 7, and further in view of Datta et al. (U.S. Pat. No. 5,695,376)

In light of the above remarks, Applicant respectfully submits that Yajima in view of Herzog and Hefe II is not sufficient to make a *prima facie* case of obviousness against claim 14 for the same reasons as stated above. Additionally, Applicant asserts that neither Hefe I, as applied to claim 14, nor Datta provide the necessary teaching or suggestion to overcome the failings of the cited disclosures and make a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that the rejection of claim 14 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Conclusion

This amendment represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. Applicant respectfully requests that the rejection of the claims be reconsidered in light of the claim amendments and arguments set forth herein and that claims 1 - 14 be allowed. Early and favorable action in the case is respectfully requested.

Respectfully submitted,

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Date: November 22, 2006
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(Amendment-Response to Office Action.doc)
Revised 04/23/2006